

Response

Applicant: Lauinger, Geoffrey A., et al.

Serial No.: 10/690,439

Filed: October 21, 2003

Docket No.: 10388US01

Title: A METHOD OF MANUFACTURING A MEDIA REFERENCE SURFACE FOR USE IN A FLEXIBLE
DATA STORAGE CARD**RECEIVED**
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REMARKS

The following remarks are made in response to the Non-Final Office Action mailed July 10, 2006. In that Office Action, claims 1-3 were rejected under 35 U.S.C. § 102(b) as anticipated by James, Albert L., U.S. Patent No. 3,175,026 ("James"), and claim 4 was rejected under 35 U.S.C. § 103(a) as unpatentable over James.

In addition, the U.S. patent references disclosed in the Information Disclosure Statement (IDS) that was received in the Patent Office on April 13, 2004, were initialed to indicate they were considered by the Examiner, which is noted with appreciation. However, the print-out of the Storcard webpage (2 pages) listed under the "Other Documents" section of the IDS was not initialed by the Examiner. It is respectfully requested that the Examiner consider this Other Document, initial the IDS, and return the marked IDS in the next Official Communication.

With this Response, claims 1-32 remaining pending in the application are presented for consideration and allowance.

Claim Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as anticipated by James.

Independent claim 1 is directed to a method of manufacturing media reference surfaces for use in a flexible data storage card. The instant specification provides at page 7, lines 14-19 that to ensure accurate and reproducible reading and writing by a read/write head, a media reference surface is provided on an interior surface of a card top of a flexible data storage card. The media reference surface is positioned opposite the read/write head and opposite the media side of a flexible media disk maintained within a housing of the flexible data storage data card. In this way, the spinning flexible media disk is constrained to a reference position between the read/write head and the media reference surface.

With the above in mind, independent claim 1 provides a method of manufacturing media reference surfaces for use in a flexible data storage card and requires providing a metal sheet having a first side and a second side, at least one side having an optically smooth surface characterized by an average surface roughness not greater than 8 micro-inch; and processing the

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metal sheet into a plurality of media reference surfaces, each media reference surface characterized by having at least one curved edge adjacent the optically smooth surface.

James teaches at column 3, lines 34-59 extruding and drawing a plastic film 6 to produce a wound roll of thin plastic film having a high degree of transparency and clarity. In particular, and with reference to FIG. 1, James teaches a plastic film 6 extruded into a gap between a cylinder 8 and a draw roll 9. By suitably adjusting the speed at which the draw roll 9 rotates relative to the extrusion speed of the film 6, James teaches a process for extruding uniformly thin films that are useful as food storage wraps and the like.

The Examiner takes the position in the Office Action mailed July 10, 2006 at page 2 that James teaches a metal sheet at element 6 in FIG. 1. We disagree. It is believed that film sheet 6 is a thermoplastic material, as provided by James at column 1, lines 10-14, and at column 3, lines 34-59.

The Examiner takes the position in the Office Action mailed July 10, 2006 at page 3 that James teaches at column 7, lines 53-55 an average surface roughness of not greater than 8 micro-inch. We disagree. It is respectfully submitted that James at column 7, lines 53-55 teaches: "The rollers 8, 9 should have a peripheral surface smoothness not rougher than 8 micro inches." (Emphasis added). Thus, the teaching in James is directed to the cylinder 8 and the draw roll 9 onto which the plastic sheet 6 is extruded, and not a metal sheet with at least one side having an optically smooth surface characterized by an average surface roughness not greater than 8 micro-inch that is processed into a plurality of media reference surfaces, as required by independent claim 1.

Even if the rollers 8, 9 in James are viewed to be a metal sheet having a first side and a second side, at least one side having an optically smooth surface characterized by an average surface roughness not greater than 8 micro-inch, it is respectfully noted that independent claim 1 further requires processing the metal sheet into a plurality of media reference surfaces. James fails to teach or suggest at least this additional limitation of independent claim 1.

Further, the Examiner takes the position that James teaches at column 3, lines 34-59 a media reference surface having at least one curved edge adjacent an optically smooth surface of

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the media reference surface. It is believed that James teaches at column 3, lines 34-59 an improved process for producing thermoplastic sheets, but fails to teach or suggest a metal sheet processed into a media reference surface that is characterized by having at least one curved edge adjacent an optically smooth surface, as required by independent claim 1.

For all of the reasons above, it is believed that claims 1-3 recite patentably distinct subject matter over James. It is respectfully requested that the rejections to claims 1-3 under 35 U.S.C. § 102(b) over James be withdrawn.

Claim 4 was rejected under 35 U.S.C. § 103(a) as unpatentable over James.

A *prima facie* case of obviousness cannot be established if the references employed are not in the inventor's field of endeavor, or reasonably pertinent to the specific problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

It is respectfully submitted that James is non-analogous art, and thus not available as a reference in a rejection under 35 U.S.C. § 103(a). The pending application provides in the specification at page 1, lines 5-7 that the present invention relates to a method of manufacturing media reference surfaces for use in a flexible data storage card, such as a StorCard[®] flexible data storage card. In this regard, it is believed that the thin film extrusion method disclosed in James is simply not from the field of endeavor of manufacturing media reference surfaces for use in a flexible data storage card.

In addition, it is believed that James is not reasonably pertinent to the particular problem of manufacturing media reference surfaces for use in a flexible data storage card, which forms the subject matter with which the applicants are involved. In particular, the Federal Circuit offers this guidance: "A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem . . . If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). It is believed that the thin film extrusion

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process of James is directed to an entirely different purpose than manufacturing media reference surfaces for use in a flexible data storage card, such that those of skill in the art of media reference surfaces would have no motivation or occasion to consider James. Thus, James is not a reasonably pertinent reference.

It is believed that James is not from the field of endeavor, nor reasonably pertinent to manufacturing media reference surfaces for use in a flexible data storage card, and is thus non-analogous art. For this reason, a *prima facie* case of obviousness cannot be established over James.

In addition, and for all of the reasons above, it is believed that James fails to teach or suggest multiple limitations of independent claim 1, such that claim 1 is believed to be non-obvious over James. Claim 4 depends from independent claim 1, and is likewise believed to be non-obvious over James. MPEP § 2143.03.

Based upon the above, it is respectfully requested that the rejection to claim 4 under 35 U.S.C. § 103(a) as unpatentable over James be withdrawn.

Objections to the Claims

Claims 5-22 were objected to by the Examiner. Although the Examiner did not detail why claims 5-22 were objected to, it is believed that these claims were objected to as depending upon a rejected base claim (independent claim 1). For the reasons above, it is believed that independent claim 1 recites patentable subject matter and that the rejection to claim 1 should be withdrawn. Thus, claims 5-22, which depend directly or indirectly from claim 1, are likewise believed to recite patentable subject matter.

It is respectfully requested that the objections to claims 5-22 be withdrawn.

CONCLUSION

Applicants respectfully submit that pending claims 1-22 recite patentable subject matter, are in form for allowance, and are not taught or suggested by the cited references. Therefore,

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reconsideration and withdrawal of the rejections and allowance of claims 1-22 is respectfully requested.

It is believed that no fees are required under the rules. However, if fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 09-0069.

The Examiner is invited to telephone the Applicants' representative at the below-listed number to facilitate prosecution of this application.

Respectfully submitted,

Date: 8/23/06

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